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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,873	07/16/2007	John Cracknell	SHP-PT088	3506

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EXAMINER

NICHOLSON III, LESLIE AUGUST

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3651

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,873	Applicant(s) CRACKNELL ET AL.	
	Examiner LESLIE A. NICHOLSON III	Art Unit 3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 26-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 37 is directed to an invention that is independent or distinct from the invention originally claimed because claim 37 discloses all and only limitations drawn from previously withdrawn claim 26.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 37 is hereby withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

2. Due to Applicant's amendments and/or arguments, all previous 35 USC 112 1st paragraph rejections as well as all previous drawing objections are hereby withdrawn. Regarding the 35 USC 112 2nd rejections, see ¶¶5,6 below.

Applicant's arguments filed 5/14/2010 have been fully considered but they are not persuasive.

Applicant argues "the disclose of McCain differs from what is claimed in that the glue is applied prior to folding multiple sheets". In response, the Examiner notes that claim 18 is directed toward an apparatus and not a method for binding sheets together. Limitations directed towards material or articles worked upon by an apparatus do not

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further structurally limit apparatus claims (see MPEP 2115). McCain discloses adhesive applied by an adhesive applicator to the fold line of selected sheets prior to stacking as shown in fig.11,15 and C5/L58-C6/L6.

Applicant argues "there is simply not teaching that would lead one to modify the applicator of Baumann to operate on individual sheets prior to stacking, as required by claim 18". In response, the Examiner disagrees. Baumann discloses the ability for the device to glue each individual conveyed sheet in at least ¶0026. Applicant further argues a problem in Baumann in that it lacks flexibility. In response, this argument is immaterial to whether the prior art, whether alone or in combination, reads on the claims. Cracknell in view of Baumann, as shown below, discloses all the limitations of the claims.

Applicant argues "...the vane (21 of Cracknell) is clearly not a finger. Nor is it retracted, as such, being merely rotatable out of position". In response, the Examiner disagrees. Claims 23-25 very broadly recite simply a first and a second retractable finger. Element 21 of Cracknell is an elongate element and therefore is a finger and is retractable in the sense that in one position it does not engage the sheets, and in another position does engage the sheets.

Applicant argues Leu discloses "the adhesive is applied to a stack of sheets and not to the fold line of selected sheets prior to stacking". In response, first the Examiner notes that at least claims 20,21 do not recite selected sheets. Furthermore, as claimed, Leu discloses applying adhesive to the stack of sheets at the fold line as shown in at least figures 1,3 and C6/L48-57.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 18-25,37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 18 recites the limitation "the reviewing sheets" in line 5 of the claim. The specification does not appear to have support for "reviewing sheets".

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 18-25,37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites the limitation "the reviewing sheets" in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim. In addition, it is unclear what reviewing sheets are.

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Claim 24 recites a second retractable finger; however, a first retractable finger was not claimed in claim 18. For the purpose of this Action, claim 24 will be treated so as to depend from claim 23, as it appears was Applicant's intention.

Claim 24 recites the limitation "the retractable fingers". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 18,19,22, as best understood by the examiner (see ¶3-6), are rejected under 35 U.S.C. 102(b) as being anticipated by McCain USP 4,050,686.

McCain discloses, regarding claim 18, binding apparatus for binding sheets together, the apparatus comprising: sheet folding apparatus (340; fig.1,5) for individually folding sheets along a fold line; a supporting surface (see fig.2) on which the sheets are supported as adhesive is applied from an adhesive applicator (300; fig.2) to the fold line of selected sheets prior to stacking; and a sheet collector (see fig.1) for stacking successive sheets such that the fold lines of each sheet are substantially aligned.

Regarding claim 19, wherein the adhesive applicator is mounted above the supporting surface and is arranged to deliver adhesive downwardly onto the outside of the fold line (fig.2).

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Regarding claim 22, wherein the supporting surface includes one or more driven rollers to urge passage of a sheet along the surface (283 and unlabeled rollers adjacent belts 296 in fig.2).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 18,19,23-25, as best understood by the examiner (see ¶3-6), are rejected under 35 U.S.C. 103(a) as being unpatentable over Cracknell WO 01/34403 in view of Baumann PGPub 2001/0048862.

Cracknell discloses, regarding claim 18, binding apparatus for binding sheets together, the apparatus comprising: sheet folding apparatus (12,13; fig.1) for individually folding sheets along a fold line; a supporting surface (33; fig.1); and a sheet collector (15) for stacking successive sheets such that the fold lines of each sheet are substantially aligned.

Regarding claim 23, wherein the sheet collector comprises a stacking area with collection arm (16) and a first retractable finger (21; fig.1,2B,3) arranged above a downstream end of the stacking area.

Regarding claim 24, wherein the collector also comprises a second retractable finger (21), the retractable fingers being arranged above the stacking area (fig.2B).

Regarding claim 25, wherein the sheet collector comprises a stacking area for receiving sequential delivery of part-folded sheets and a finger (21) located above a downstream end of the stacking area and arranged for rotation about an axis substantially transverse to the sheet transport direction (which can be the direction of conveyance of the sheets by way of elements 36 or 41; fig.1).

Cracknell does not expressly disclose an adhesive applicator or the limitations of claim 19.

Baumann teaches the use of an adhesive applicator (30), , wherein the adhesive applicator is mounted above the supporting surface and is arranged to deliver adhesive downwardly onto the outside of the fold line for the purpose of joining each signature to one another in order to collect the signature into groups to form the desired end product (¶0002,0019-0022).

At the time of invention it would have been obvious to one having ordinary skill in the art to provide an adhesive applicator, wherein the adhesive applicator is mounted above the supporting surface and is arranged to deliver adhesive downwardly onto the outside of the fold line, as taught by Baumann, in the device of Cracknell, for the purpose of joining each signature to one another in order to collect the signature into groups to form the desired end product.

11. Claims 20,21, as best understood by the examiner (see ¶3-6), are rejected under 35 U.S.C. 103(a) as being unpatentable over Cracknell WO 01/34403 in view of Baumann PGPub 2001/0048862 further in view of Leu USP 5,716,182.

Cracknell discloses substantially all the limitations of the claim (see ¶10), but does not expressly disclose the limitations of claims 20,21.

Leu teaches the device wherein the adhesive applicator (20) is mounted in or adjacent a slot in the supporting surface and is arranged to deliver adhesive upwardly through the slot to the inside of the fold line and wherein the adhesive applicator is arranged to deliver adhesive to the second and subsequent sheets of a stack (C6/L48-57) for the purpose of ensuring reliable adhesive bonding between individual sheets without problems of blockage (C2/L10-17).

At the time of invention it would have been obvious to one having ordinary skill in the art to mount the adhesive applicator in or adjacent a slot in the supporting surface and is arranged to deliver adhesive upwardly through the slot to the inside of the fold line and wherein the adhesive applicator is arranged to deliver adhesive to the second and subsequent sheets of a stack, as taught by Leu, in the device of Cracknell, for the purpose of ensuring reliable adhesive bonding between individual sheets without problems of blockage.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LESLIE A. NICHOLSON III whose telephone number is (571)272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gene Crawford/
Supervisory Patent Examiner, Art
Unit 3651

/L. A. N./
Examiner, Art Unit 3651
6/2/2010